



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hideaki IMURA et al.

Application No.: 10/697,041

Filed: October 31, 2003

For: GAMING MACHINE

Attorney Docket No.: SHO-0036

Group Art Unit: 3714

Examiner: A. Kim

Confirmation No.: 8363

APPEAL BRIEF

MS APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Under 37 C.F.R. §41.37, this Appeal Brief is in furtherance of the Notice of Appeal, filed in the above-identified application concurrently herewith, and appeals the final decision of the Examiner in the final Office Action dated May 21, 2007.

The fees required under § 41.20 and any required petition for extension of time for filing this brief and fees therefor, are provided in the accompanying Transmittal of Appeal Brief. Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

In compliance with 37 C.F.R. §41.37(a)(1), one (1) copy of this Appeal Brief is hereby filed.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37:

- I. Real Party In Interest
- II Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter

- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Arguments
- VIII. Claims
- IX. Evidence
- X. Related Proceedings
- XI. Conclusion

Claims Appendix

Drawing Figure(s) Appendix

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Aruze Corp. of Tokyo, Japan ("Aruze ") is the real party in interest of the present application. An assignment of all rights in the present invention to Aruze was executed by the inventors and recorded by the United States Patent and Trademark Office on reel 015193, frame 0905.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claim 1	(rejected)	now being appealed
Claim 2	(rejected)	now being appealed
Claim 3	(rejected)	now being appealed
Claim 4	(rejected)	now being appealed
Claim 5	(rejected)	now being appealed
Claim 6	(rejected)	now being appealed
Claim 7	(rejected)	now being appealed
Claim 8	(rejected)	now being appealed
Claim 9	(rejected)	now being appealed
Claim 10	(rejected)	now being appealed

Claim 11 (rejected) now being appealed
Claim 12 (rejected) now being appealed

IV. STATUS OF AMENDMENTS

The Examiner issued an Advisory Action dated August 31, 2007, in response to Applicant's Amendment after Final Rejection under 37 CFR 1.116 filed on August 21, 2007. Applicants' Amendment after Final Rejection was filed in response to the final Office Action dated May 21, 2007. Only claim 1 was amended in Applicants' Amendment after Final Rejection with such amendments being entered for purposes of appeal as noted in the Advisory Action.

Accordingly, claims 1-12 enclosed herein and recited in Appendix A are the pending claims of the application.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is directed to a gaming machine (page 13, line 7, et seq.; Figures 1 and 2) that includes a variable display device 3(3L, 3C, 3R)(page 5, line 17, et seq.; Figures 2-7), an image display device 504(page 5, lines 21, et seq.; Figures 5, 6 and 8), a symbol illumination device 513(513L, 513C, 513R)(page 5, line 25, et seq.; Figure 8) and an image display assistance device 320(320L, 320R)(page 6, lines 1-2, et seq.; Figures 3, 5 and 8). The variable display device 3(3L, 3C, 3R) is configured to variably display a plurality of symbol rows 340L, 340C, 340R(page 14, lines 21 and 22; Figure 4) with each having a symbol placement face (page 5, line 19; Figures 3 and 5-7) formed in a curved surface (page 35, lines 7-8; Figures 3 and 5-7) on which a plurality of symbols (page 5, line 20; Figure 4) are placed. The image display device 504 is provided in front of and is opposed to the variable display device 3(3L, 3C, 3R) and is configured to display the symbols through a flat symbol transmission face 5(5a)(page 5, lines 23-24; Figures 1 and 5) and to display an image concerning a game (page 5, line 19; Figures 3 and 5-7). The symbol illumination device 513 is configured to illuminate the symbols. The image display assistance device 320 is provided lateral to an area (Figure 3) between the variable display device 3(3L, 3C, 3R) and the image display device 504 to cover an area sandwiched between the symbol placement face and the symbol transmission face (page 6, lines 3-5) and is configured to assist image display of the image display device 504.

Claim 2 is directed to a gaming machine (page 13, line 7, et seq.; Figures 1 and 2) that includes a variable display device 3(3L, 3C, 3R)(page 5, line 17, et seq.; Figures 2-7), an image display device 504(page 5, line 21, et seq.; Figures 5, 6 and 8), a symbol illumination device 513(513L, 513C, 513R)(page 5, line 25, et seq.; Figure 8) and an image display assistance device 320(320L, 320R)(page 6, lines 1-2, et seq.; Figures 3, 5 and 8). The variable display device 3(3L, 3C, 3R) is configured to variably display a plurality of symbol rows 340L, 340C, 340R(page 14, lines 21 and 22; Figure 4) on which a plurality of symbols (page 5, line 20; Figure 4) are placed. The image display device 504 is provided in front of the variable display device 3(3L, 3C, 3R) and is configured to display an image concerning a game (page 5, line 24). The symbol illumination device 513 is configured to illuminate the symbols. The image display assistance device 320 is provided lateral to an area (Figure 3) between the variable display device 3(3L, 3C, 3R) and the image display device 504 and is configured to reflect light emitted from the symbol illumination device 513 and to assist image display of the image display device.

Claim 8 is directed to a gaming machine (page 13, line 7, et seq.; Figures 1 and 2) that includes a variable display device 3(3L, 3C, 3R)(page 5, line 17, et seq.; Figures 2-7), an image display device 504(page 5, line 21, et seq.; Figures 5, 6 and 8) and a side illumination device 1325(page 7, lines 5-6; Figure 12). The variable display device 3(3L, 3C, 3R) is configured to variably display a plurality of symbol rows 340L, 340C, 340R(page 14, line 21 and 22; Figure 4) on which a plurality of symbols (page 5, line 20; Figure 4) are placed. The image display device 504 is provided in front of the variable display device 3(3L, 3C, 3R) and configured to display an image concerning a game (page 5, line 24). The side illumination device 1325 is provided lateral to an area (Figure 3) between the variable display device 3(3L, 3C, 3R) and the image display device 504 and is configured to illuminate the symbols from a side of the symbols (page 7, lines 7-8).

Claim 10 is directed to a gaming machine (page 13, line 7, et seq.; Figures 1 and 2) that includes a first display device 3(3L, 3C, 3R)(page 5, line 17, et seq.; Figures 2-7), a second display device 504(page 5, line 21, et seq.; Figures 5, 6 and 8) and a display assistance device 320(320L, 320R)(page 6, lines 1-2, et seq.; Figures 3, 5 and 8). The first display device 3(3L, 3C, 3R) is configured to variably display a plurality of symbols (page 5, line 20; Figure 4). The second display device 504 includes a display panel 504(page 5, line 21, et seq.; Figures 5, 6 and 8) that is provided opposed to and

spaced from the first display device 3(3L, 3C, 3R). The second display device 504 is configured to display the symbols (page 5, line 20; Figure 4) through the display panel 504 and to display an image concerning a game on the display panel (page 5, line 24). The display assistance device 320 (320L, 320R) is provided lateral to an area (Figure 3) between the first display device 3(3L, 3C, 3R) and the display panel 504 of the second display device 504 and is configured to assist image display of the second display device 504.

VI. Grounds of Rejection to be Reviewed on Appeal

Claim 1, 2, 3 and 5-12 are rejected under 35 U.S.C. 103(a) as unpatentable over Mizukai et al. (JP 2001-161950).

Claim 4 is rejected under 35 U.S.C. 103(a) as unpatentable over Mizukai in view of Ozaki et al. (U.S. Patent Application Publication No. 2001/0031658).

VII. ARGUMENTS

Rejection of Claim 1, 2, 3 and 5-12 under 35 U.S.C. §103(a)

Claim 1, 2, 3 and 5-12 are rejected under 35 U.S.C. 103(a) as unpatentable over Mizukai et al. (JP 2001-161950). The rejection is respectfully traversed.

In rejecting claims under 35 U.S.C. §103, the United States Patent and Trademark Office bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. "A *prima facie* case of obviousness is established if the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (CCPA 1776). The mere fact that the prior art *may* be modified in the manner suggested by the Examiner neither makes the modification *prima facie* obvious or obvious unless the prior art suggested the desirability of the modification. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by

some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led the individual to combine the relevant teachings of the references to arrive at the claimed invention. If the Examiner fails to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned.

In addition to the above (commonly referred to as the TSM test or teaching, suggestion, motivation test), Examiners can make appropriate rejections regarding the obviousness of claimed inventions in light of the recent Supreme Court's decision in KSR International Co. v. Teleflex Inc., 550 U.S. ___, 82 USPQ2d 1385 (2007). The familiar factual inquiries announced by the Supreme Court in its much earlier decision, Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), remain the basis for every decision regarding obviousness, i.e., Examiners will continue to consider:

- (1) the scope and content of the prior art,
- (2) the differences between the claimed invention and the prior art,
- (3) the level of ordinary skill in the pertinent art, and
- (4) objective evidence relevant to the issue of obviousness.

Mizukai et al. disclose a symbol variable display including a large-sized ornament component on which a visible display part is formed. The visible display part conforms to a lens section of a symbol variable display. The symbol variable display includes a transparent member, a hold case member, symbol display units and an electric control board. The transparent member has a single-piece construction made of transparent synthetic resin and includes a frame part and the lens part that conforms to the visible display part.

Regarding Claims 1, 2, 8 and 10, it is respectfully submitted that Mizukai fails to teach "the image display device ... configured to display an image concerning a game." Mizukai merely teaches a transparent member as the visible display part.

Further, especially with regard to claim 1, Mizukai does not teach "image display device ... through a flat symbol transmission face" as claimed but merely teaches the lens section 23 having a concave shape.

As described above, since Mizukai does not disclose the image display, Mizukai fails to teach "the image display assistance device ... configured to assist image display of the image display device" as recited in claims 1, 2 and 10.

Mizukai does not teach or suggest "the image display assistance device ... being provided lateral to an area between the variable display device and the image display device ...".

The Examiner alleges that it would have been obvious to place reflecting plates of Mizukai to the area between the symbols and the image display to assist in illuminating the area in front of the symbol face without obstructing the player's view of the symbol.

Mizukai does not teach the image display of the image display device but merely teaches the reflecting plate (57) for indirectly illuminating the area behind the symbol drum (37) (see paragraph 0021). Therefore, it is respectfully submitted that it would not be obvious to place the image display lateral to the area, which is configured to assist image display of the image display device as claimed in claims 1, 2 and 10.

Furthermore, regarding claims 1, 2, 8 and 10, the Examiner simply points out that it would be obvious to place the reflecting plate of Mizukai lateral to an area between the variable display device and the image display device. The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led the individual to combine the relevant teachings of the reference to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). It is respectfully submitted that the conclusion of obviousness is based upon the Applicants' invention and, thus, is considered hindsight reconstruction.

Additionally, it is respectfully submitted that the results and advantages are a part of the claimed invention as a whole. It is a basic tenet of patent law that the U.S. Patent and Trademark Office is not permitted to ignore the results and advantages produced by claimed subject matter, of which the prior art is devoid, simply because the claimed limitations are similar to that otherwise barren prior art. Diversitech Corp. v. Century

Steps, Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988); In re Chupp, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987); Formson v. Advance Offset Plate, 755 F.2d 1549, 225 USPQ 26 (Fed. Cir. 1985).

To this end, claim 1 recites (a) an image display device ... configured to display the symbols through a flat symbol transmission face and to display an image concerning a game; and (b) an image display assistance device being provided lateral to an area between the variable display device and the image display device. In the summary section of the specification, the problem of producing the black triangular region is discussed, when a display (not a simple transparent resin) having a flat face is used. In addition, the summary section also indicates this problem does not occur when no liquid crystal is provided on the front of the display window (that is, the display window has no image display function). In order to solve the problem, the image assistance device is provided lateral to ..., as claimed. Mizukai's visible part does not have the flat symbol transmission face and also does not display an image. Therefore, it would not have been obvious to place the image display assistance device lateral to the area as claimed.

It is respectfully submitted that that the applied art fails to teach or suggest the features of the claims as discussed above. Thus, it is respectfully submitted that one of ordinary skill in the art would not be motivated to modify the features of the applied art because such reference is devoid of such claimed features. As a result, it is respectfully submitted that the claims 1, 2, 8 and 10, at least for the reasons discussed above, are allowable over the applied art.

Claims 3 and 5 -7 depend from claim 1 and includes all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Claim 9 depends from claim 8 and includes all of the features of claim 8. Thus, it is respectfully submitted that the dependent claim is allowable at least for the reasons claim 8 is allowable as well as for the features it recites.

Claims 11 and 12 depend from claim 10 and includes all of the features of claim 10. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 10 is allowable as well as for the features they recite.

Withdrawal of the rejection is respectfully requested.

Rejection of Claim 4 under 35 U.S.C. §103(a)

Claim 4 is rejected under 35 U.S.C. 103(a) as unpatentable over Mizukai in view of Ozaki et al. (U.S. Patent Application Publication No. 2001/0031658). The rejection is respectfully traversed.

Claim 4 depends from claim 1 and includes all of the features of claim 1. Thus, it is respectfully submitted that the dependent claim is allowable at least for the reason claim 1 is allowable as well as for the features it recites.

Withdrawal of the rejection is respectfully requested.

VIII. CLAIMS

A copy of the claims involved in this appeal is attached hereto in the Claims Appendix.

IX. EVIDENCE

No evidence is being presented and therefore there is no Evidence Appendix.

X. RELATED PROCEEDINGS

None.

XI. CONCLUSION

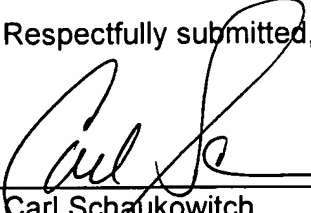
It is respectfully submitted that the Examiner had failed to establish a *prima facie* case of obviousness for the reasons set forth above under either the TSM (teaching,

suggestion and motivation) test or under the criteria set forth in Graham v. John Deere Co., supra. It is respectfully requested the Board overturn the rejection and allow the pending claims.

Respectfully submitted,

Dated: February 25, 2008

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Enclosure(s): Transmittal of Appeal Brief
Claims Appendix
Drawing Figure(s) Appendix
Figures 1-8 and 12

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CLAIMS APPENDIX

Claims Involved in the Appeal of Application No. 10/697,041

1. (Previously Presented) A gaming machine comprising:
a variable display device configured to variably display a plurality of symbol rows each having a symbol placement face formed in a curved surface on which a plurality of symbols are placed;
an image display device being provided in front of and opposed to the variable display device and configured to display the symbols through a flat symbol transmission face and to display an image concerning a game;
a symbol illumination device configured to illuminate the symbols; and
an image display assistance device being provided lateral to an area between the variable display device and the image display device to cover an area sandwiched between the symbol placement face and the symbol transmission face, and configured to assist image display of the image display device.

2. (Previously Presented) A gaming machine comprising:
a variable display device configured to variably display a plurality of symbol rows on which a plurality of symbols are placed;
an image display device being provided in front of the variable display device and configured to display an image concerning a game;
a symbol illumination device configured to illuminate the symbols; and
an image display assistance device being provided lateral to an area between the variable display device and the image display device and configured to reflect light emitted from the symbol illumination device and to assist image display of the image display device.

3. (Previously Presented) The gaming machine as claimed in claim 1, wherein the symbol illumination device comprises a rear illumination lamp configured to illuminate the symbols from behind the symbols, and
wherein the image display assistance device reflects light emitted from the rear illumination lamp.

4. (Previously Presented) The gaming machine as claimed in claim 1, wherein the symbol illumination device comprises a front illumination lamp configured to illuminate the symbols from a slanting direction of the front of the symbols, and wherein the image display assistance device reflects light emitted from the front illumination lamp.

5. (Previously Presented) The gaming machine as claimed in claim 1, wherein the image display assistance device is attached to a housing that houses the variable display device.

6. (Previously Presented) The gaming machine as claimed in claim 1, wherein the image display assistance device comprises a white plate.

7. (Previously Presented) The gaming machine as claimed in claim 1, wherein the image display assistance device comprises a mirror plate.

8. (Previously Presented) A gaming machine comprising:
a variable display device configured to variably display a plurality of symbol rows on which a plurality of symbols are placed;
an image display device being provided in front of the variable display device and configured to display an image concerning a game; and
a side illumination device being provided lateral to an area between the variable display device and the image display device and configured to illuminate the symbols from a side of the symbols.

9. (Previously Presented) The gaming machine according to claim 8, further comprising a case that houses at least a part of the variable display device, wherein the side illumination device includes a plate attached to the case and a lighting device provided on the plate.

10. (Previously Presented) A gaming machine comprising:
a first display device configured to variably display a plurality

of symbols;

a second display device including a display panel that is provided opposed to and spaced from the first display device, and the second display device configured to display the symbols through the display panel and to display an image concerning a game on the display panel; and

a display assistance device provided lateral to an area between the first display device and the display panel of the second display device and configured to assist image display of the second display device.

11. (Previously Presented) The gaming machine according to claim 10, further comprising an illumination device configured to illuminate the symbols,

wherein the display assistance device includes a reflector that reflects light emitted from the illumination device.

12. (Previously Presented) The gaming machine according to claim 10, wherein the display assistance device includes an illumination device that illuminates the area between the first display device and the display panel of the second display device.

EVIDENCE APPENDIX

(There is no evidence being presented)

RELATED PROCEEDINGS

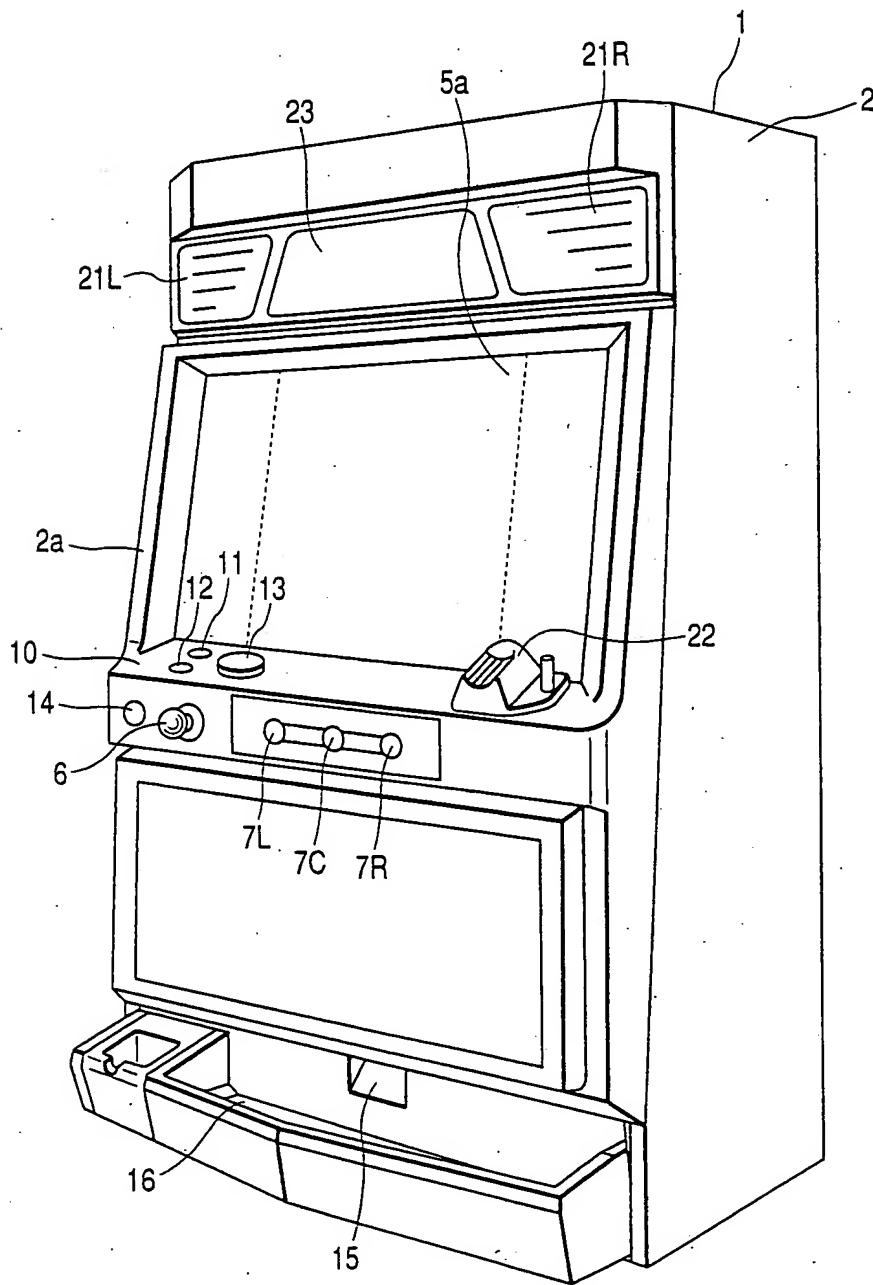
(None)



DRAWING FIGURES APPENDIX

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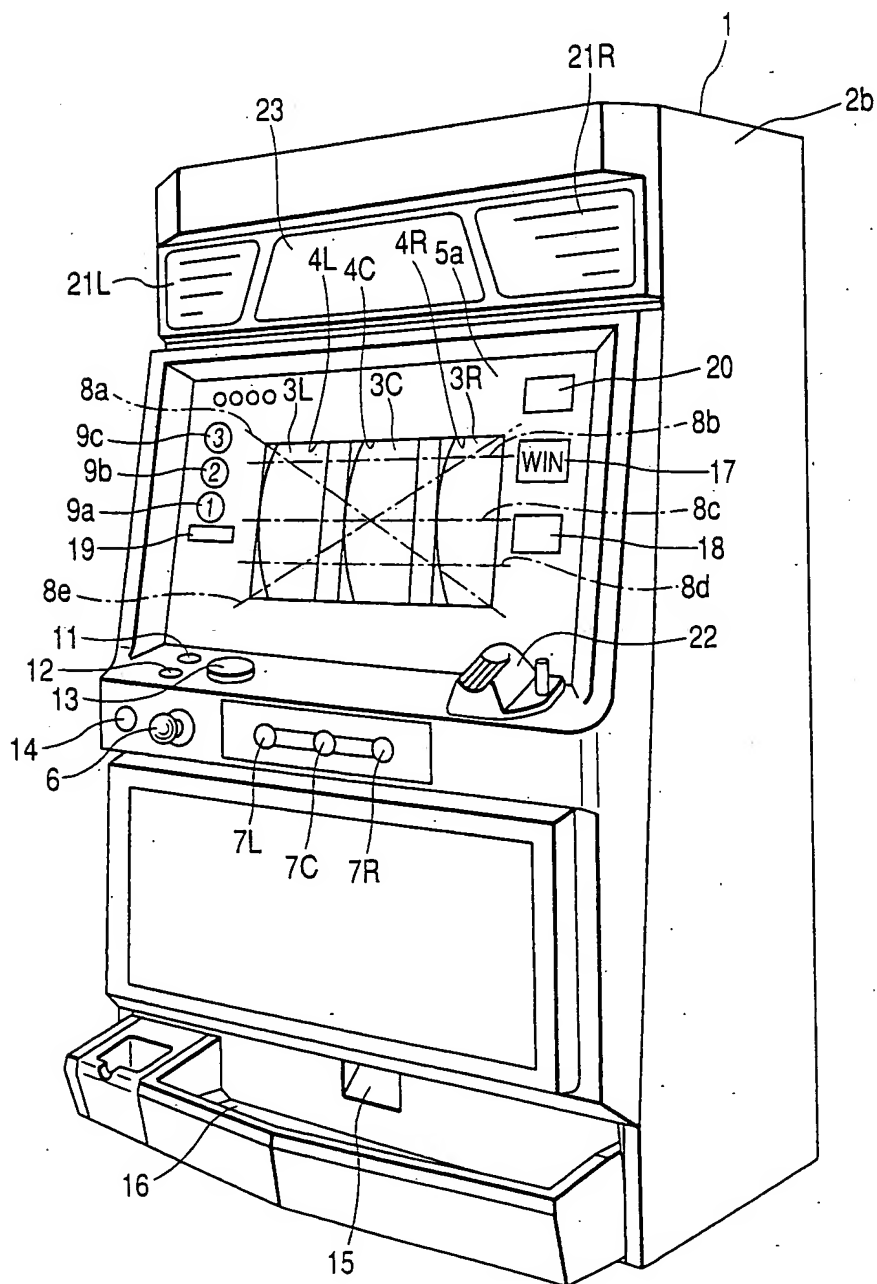
FIG. 1



DRAWING FIGURES APPENDIX

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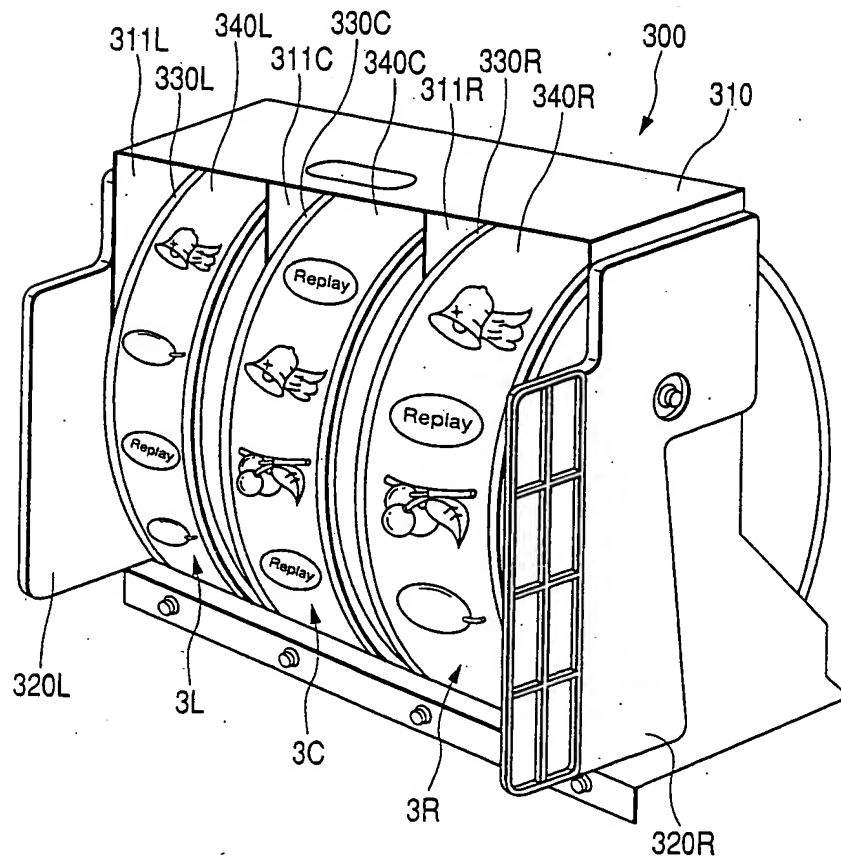
FIG. 2



DRAWING FIGURES APPENDIX

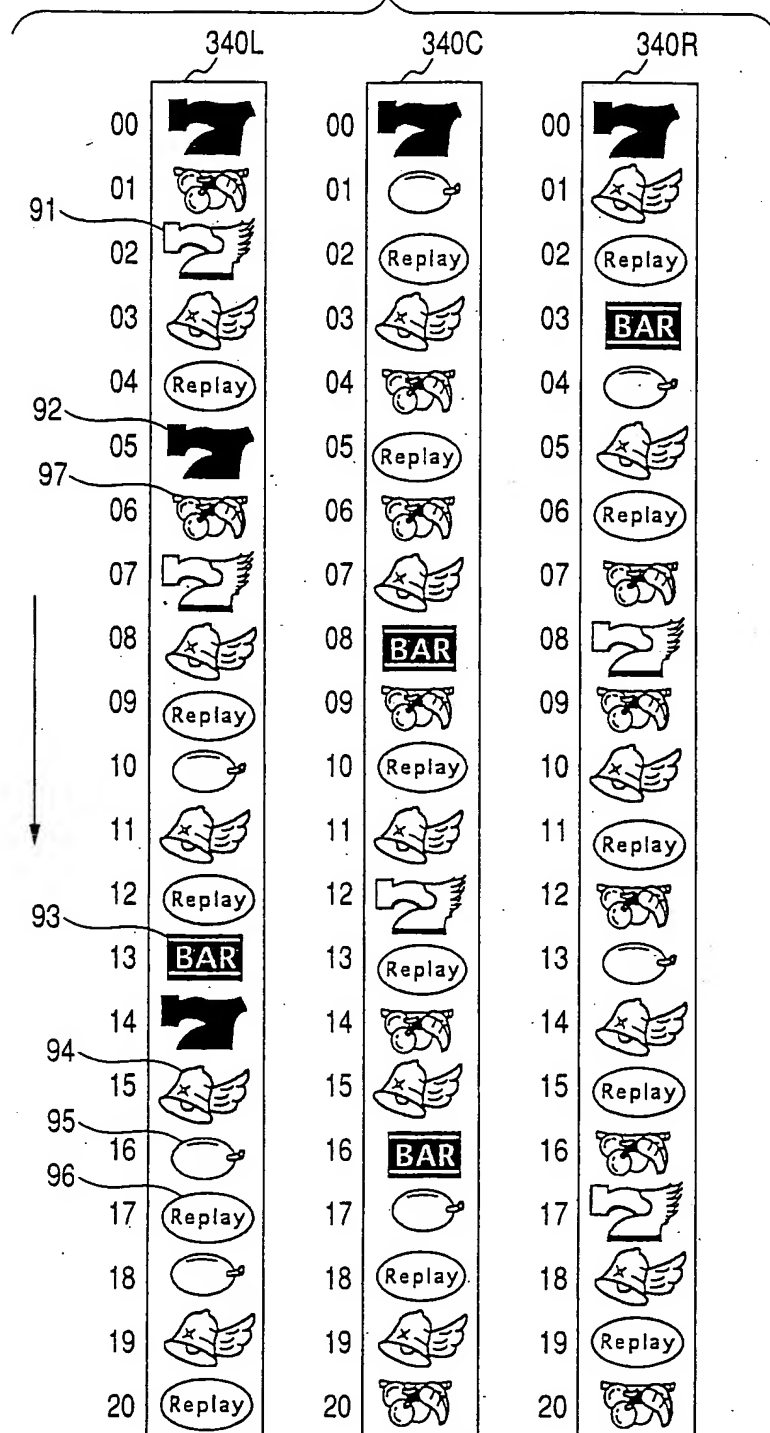
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FIG. 3



DRAWING FIGURES APPENDIX

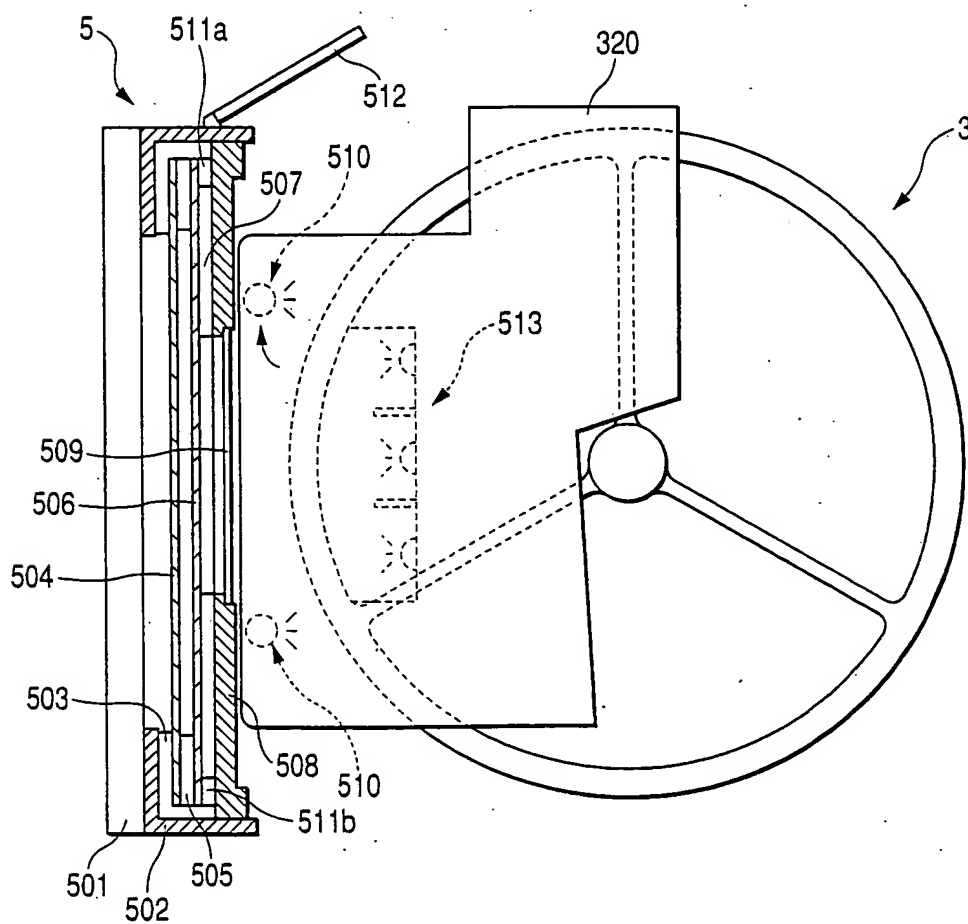
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FIG. 4

DRAWING FIGURES APPENDIX

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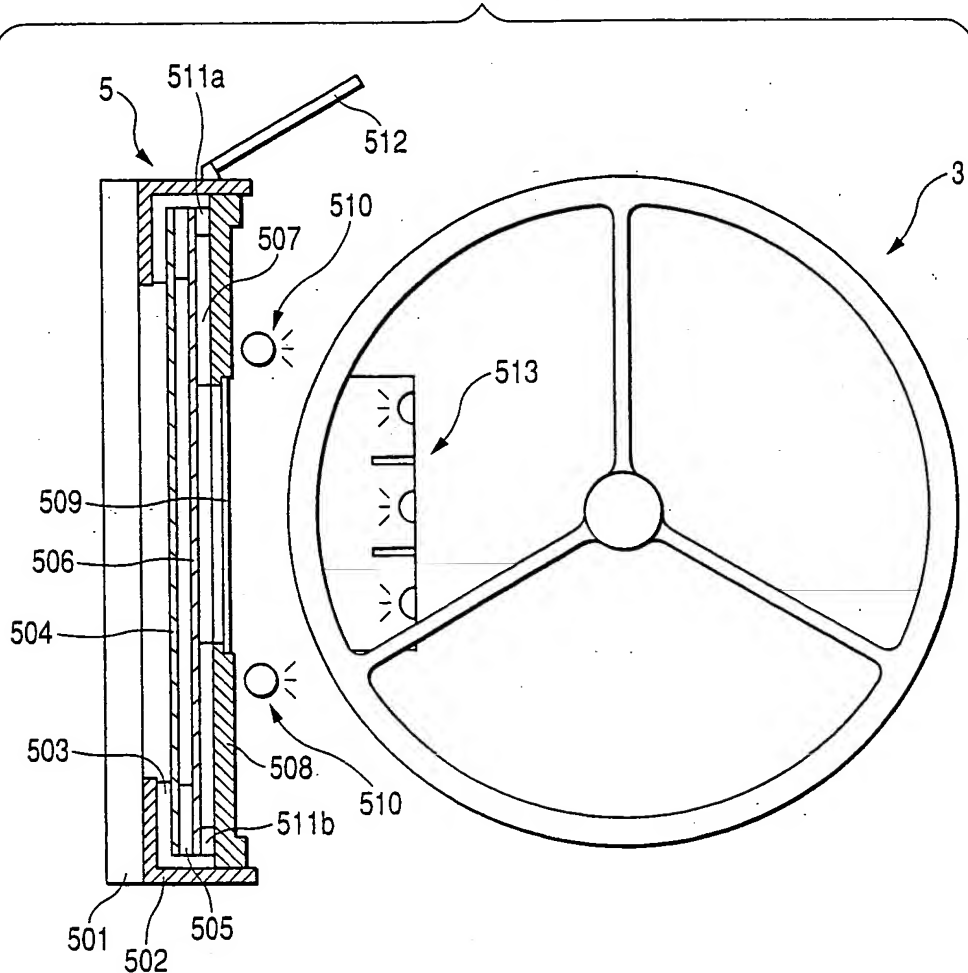
FIG. 5



DRAWING FIGURES APPENDIX

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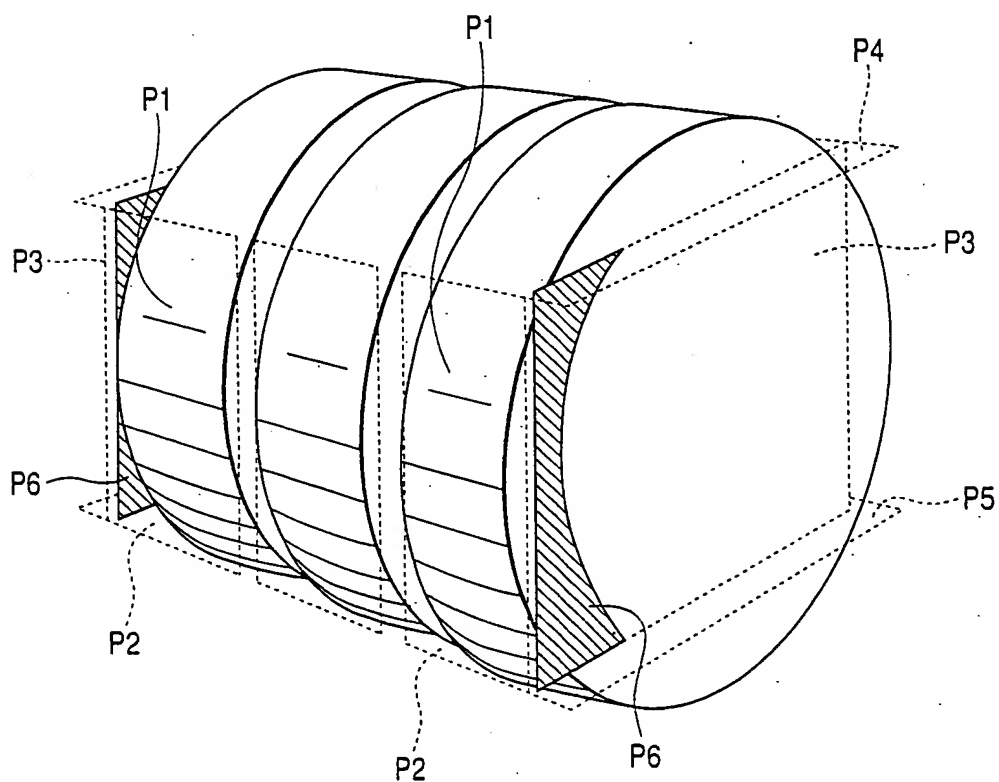
FIG. 6



DRAWING FIGURES APPENDIX

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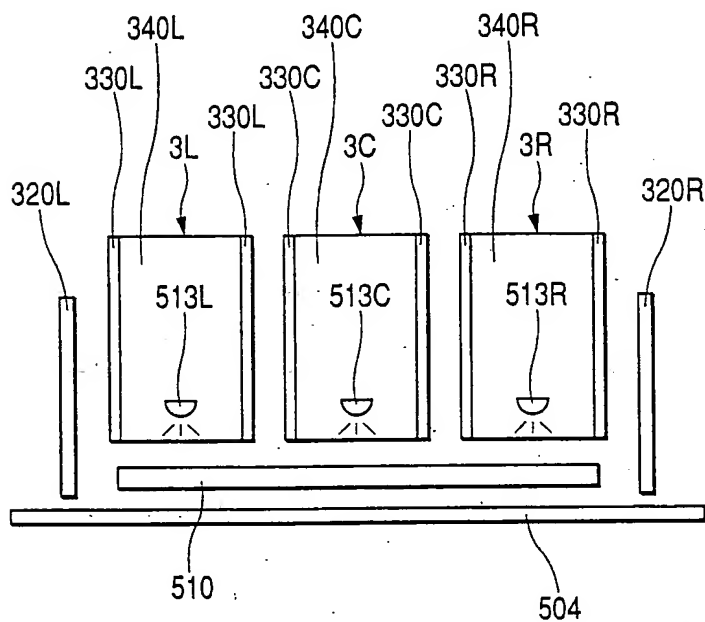
FIG. 7



DRAWING FIGURES APPENDIX

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FIG. 8



DRAWING FIGURES APPENDIX

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FIG. 12

